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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,273	01/23/2004	Chikara Morisada	00862.023439.	5785.

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FITZPATRICK CELLA HARPER & SCINTO  
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NEW YORK, NY 10112

EXAMINER
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KIM, PAUL

ART UNIT	PAPER NUMBER
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2161

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/762,273	<b>Applicant(s)</b> MORISADA ET AL.	
	<b>Examiner</b> Paul Kim	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This Office action is responsive to the following communication: Amendment filed on 26 October 2006.
2. Claims 1-5, and 7-9 are pending and present for examination. Claims 1, 7, and 8 are independent.

### *Drawings*

3. As per the objection to the Drawings, applicant's amendment has been acknowledged. Accordingly, the objection has been withdrawn.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. **Claims 1-5 and 7-9** are rejected under 35 U.S.C. 102(a) as being anticipated by Murakami et al (EP 1 286 292, hereinafter referred to as MURAKAMI), filed on 16 August 2002, and published on 26 February 2003.
6. **As per independent claims 1 and 7-8**, MURAKAMI teaches:

A method of controlling a server apparatus which stores in a memory image data received via a network, comprising the steps of:

setting a disclosure date of the received image data {See MURAKAMI, Para. 0042, wherein this reads over "[t]he attached file is an image data file"; and Para. 0085, wherein this reads over "a timer means that ticks the time, and designates the date and time when the e-mail is to be transmitted to the mail-with-entry information creation unit on the basis of the transmission date/time designation information"};

processing the received image data to create processed image data {See MURAKAMI, Para. 0099, wherein this reads over "plural applications for processing the attached file and, for

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example, when the attached file is image data, the processing unit activates an application for performing image processing");

comparing a time ticked in the server apparatus and the set disclosure date {See MURAKAMI, Para. 0085, wherein this reads over "a timer means that ticks the time, and designates the date and time when the e-mail is to be transmitted to the mail-with-entry information creation unit on the basis of the transmission date/time designation information"};

creating page information for displaying the processed image data when the time ticked in the server apparatus is determined to be earlier than the set disclosure date {See MURAKAMI, Para. 0014, wherein this reads over "the data of the attached file are shared on the server, whereby plural clients can view the attached file"}, and creating page information for displaying the received image data when the time ticked in the server apparatus is determined to be the set disclosure date {See MURAKAMI, Para. 0087, wherein this reads over "[t]he remainder setting unit instructs to the mail-with-entry-information creation unit to transmit an e-mail when the timer included in the remainder setting unit shows the date and time designated by the transmission date/time designation information"}; and

transmitting, via the network, the created page information for displaying the processed image data before the set disclosure date, and transmitting the created page information for displaying the received image data on the set disclosure date, to a specified recipient {See MURAKAMI, Para. 0094, wherein this reads over "the e-mail A that is transmitted"}.

7. **As per dependent claim 2, MURAKAMI teaches:**

The method according to claim 1, wherein said processing step creates a plurality of processed image data, and further comprising a step of setting a level of processing performed for the received image data to create each processed image data {See MURAKAMI, Para. 0099, wherein this reads over "plural applications for processing the attached file and, for example, when the attached file is image data, the processing unit activates an application for performing image processing"}.

8. **As per dependent claim 3, MURAKAMI teaches:**

The method according to claim 1, further comprising the steps of:

setting a date of creating the page information for displaying the processed image data {See MURAKAMI, Para. 0042, wherein this reads over "[t]he attached file is an image data file"; and Para. 0085, wherein this reads over "a timer means that ticks the time, and designates the date and time when the e-mail is to be transmitted to the mail-with-entry information creation unit on the basis of the transmission date/time designation information"}; and

determining whether the time ticked in the server apparatus is the same as the set date of creating the page information for displaying the processed image data {See MURAKAMI, Para. 0085, wherein this reads over "a timer means that ticks the time, and designates the date and time when the e-mail is to be transmitted to the mail-with-entry information creation unit on the basis of the transmission date/time designation information"}, and

wherein said step of creating the page information for displaying the processed image data is executed when the time ticked in the server apparatus is determined to be the same as the date of creating the page information {See MURAKAMI, Para. 0087, wherein this reads over "[t]he remainder setting unit instructs to the mail-

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with-entry-information creation unit to transmit an e-mail when the timer included in the remainder setting unit shows the date and time designated by the transmission date/time designation information").

9. **As per dependent claim 4, MURAKAMI teaches:**

The method according to claim 1, wherein a same address in the network is assigned for transmitting the page information for displaying the processed image data and the page information for displaying the received image data {See MURAKAMI, Para. 0055, wherein this reads over "[t]he URL creation unit creates a URL indicating the entry position of the attached file on the basis of the entry position information" and "creates an e-mail B on the basis of the second e-mail creation information that is outputted from the analysis authentication unit, and the URL that is outputted").

10. **As per dependent claim 5, MURAKAMI teaches:**

The method according to claim 1, wherein said processing includes at least one of mosaic processing, emboss processing, and wipe processing {See MURAKAMI, Para. 0099, wherein this reads over "plural applications for processing the attached file and, for example, when the attached file is image data, the processing unit activates an application for performing image processing" and "processing form such as 'monochrome' or 'mosaic'"}.

11. **As per dependent claim 9, MURAKAMI teaches:**

The method according to claim 2, further comprising the steps of:

setting a date of creating the page information for displaying the processed image data {See MURAKAMI, Para. 0042, wherein this reads over "[t]he attached file is an image data file"; and Para. 0085, wherein this reads over "a timer means that ticks the time, and designates the date and time when the e-mail is to be transmitted to the mail-with-entry information creation unit on the basis of the transmission date/time designation information"}; and

determining whether the time ticked in the server apparatus is the same as the set date of creating the page information for displaying the processed image data {See MURAKAMI, Para. 0085, wherein this reads over "a timer means that ticks the time, and designates the date and time when the e-mail is to be transmitted to the mail-with-entry information creation unit on the basis of the transmission date/time designation information"},

wherein said step of creating the page information for displaying the processed image data is executed when the time ticked in the server apparatus is determined to be the same as the set date of creating the page information {See MURAKAMI, Para. 0087, wherein this reads over "[t]he remainder setting unit instructs to the mail-with-entry-information creation unit to transmit an e-mail when the timer included in the remainder setting unit shows the date and time designated by the transmission date/time designation information"}.

### ***Response to Arguments***

12. Applicant's arguments filed 26 October 2006 have been fully considered but they are not persuasive.

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a. **Applicant's Arguments:**

i. Rejections under 35 U.S.C. 102(a)

Applicant requests clarification of the grounds of the rejections.

Applicant asserts the argument that "the applied art of Murakami is not seen to disclose or to suggest the features of the present invention, and in particular, is not seen to disclose or to suggest at least the features of creating page information for displaying processed image data when a time ticked in a server apparatus is determined to be earlier than a set disclosure date, and transmitting the created page information for displaying the processed image data before the set disclosure date to a recipient" (See Amendment, page 9).

b. **Response to Arguments:**

i. Rejections under 35 U.S.C. 102(a)

As per Applicant's request for further clarification of the grounds of the rejections, Examiner respectfully submits that Murakami qualifies as prior art under 35 U.S.C. 102(a) and has been applied accordingly in the present Office action.

As per Applicant's argument that Murakami does not disclose or suggest "creating page information for displaying processed image data when a time ticked in a server apparatus is determined to be earlier than a set disclosure date," the Examiner respectfully disagrees. It is noted that the features upon which applicant relies (i.e., displaying processed image data) are optionally recited in the rejected claims since the claims include an intended use. The recitation of "creating page information for displaying processed image data" and "transmitting the created page information for displaying the processed image data" provide a limitation wherein the page information is created for the intended use of displaying processed image data (emphasis added). Therefore, since the intended use language, "for displaying processed image data," is

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optional and not afforded any patentable weight, it is noted that Murakami does indeed read on the claim limitations of creating and transmitting page information.

Accordingly, the rejections under 35 U.S.C. 102(a) are sustained.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

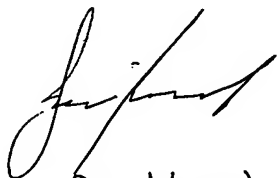
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is (571) 272-2737. The examiner can normally be reached on M-F, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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TECH Center 2100



Sana Al-Hashem